

REMARKS

Claims 39-86 were previously presented. Claims 40-49 were rejoined in view of Applicant's amendments. The Examiner withdrew claims 50-68 and 72-77 from consideration in view of Applicant's election with traverse of Group IV. Claims 69, 81, and 85 are amended. Claims 39-49, 69-71, and 78-86 are pending.

Restriction Requirement

Despite Applicant's arguments presented in the amendment filed on December 31, 2007, the Office Action deemed the species restriction requirement proper and made FINAL. Applicant respectfully request reconsideration since the cited groups are not individual species, instead they have overlapping scope.

A requirement for restriction to a single species may be proper if the species are *mutually exclusive*. See MPEP § 806.04(f) (emphasis added). Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. See id. Therefore, "to require restriction between claims limited to species, the claims must not overlap in scope." See id.

Applicant respectfully submits that there are embodiments in each of the groups defined in the Office Action which are contained in each of the other groups. Accordingly, the groups are not believed to be mutually exclusive as required by MPEP § 806.04(f), and therefore the species restriction requirement is believed to be improper. Applicant respectfully requests the Examiner to reconsider the restriction on this issue, and maintains the traverse to preserve Applicant's right to petition for rejoinder of these claims to the present Application.

Rejections under 35 USC § 103

Claims 39-49, 69-71, and 78-85¹ were rejected under 35 U.S.C. § 103(a) as being unpatentable over Behm et al. (US 2002/0119817) in view of Paulsen (US 2003/0186739), and Rock, Jr. et al. (US 2004/0111326). Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness because of non-obvious patentable differences between the cited references and claims 39-49, 69-71, and 78-90.

¹ Applicant notes that the Office Action Summary provides that Claim 86 is rejected, while the paragraph 4 on page 3 of the office action does not.

Therefore, claims 39-49, 69-71, and 78-86 define over the cited references.

The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy

According to MPEP §2141, it is Office policy to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. §103. A determination of obviousness under §103 requires the determination of the following factual inquiries: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations, if any. Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the Examiner must evaluate the evidence. MPEP §2141. *See Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57527 (Oct. 10, 2007).

Based on these factual inquiries, the obviousness or nonobviousness of the claimed subject matter is determined. A conclusion of obviousness must be supported with some articulated reasoning with some rational underpinning; mere conclusory statements are not sufficient. *See* 72 Fed. Reg. 57526 at 57528-29.

As noted in MPEP §706.02(j) (entitled “Contents of a 35 U.S.C. 103 Rejection”): “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner

must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)). Also, as stated in MPEP §2142 (entitled “Legal Concept of Prima Facie Obviousness”):

The legal concept of prima facie obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. . . The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

. . . .

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person.

Also, as noted in MPEP §2143.01 (entitled, “Suggestion or Motivation To Modify the References”), it is stated in pertinent part:

IV. MERE STATEMENT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS - A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE - If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

VI. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE - If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

For at least the following reasons, applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness against the presently amended claims of the patent application, because the cited references, whether taken alone or in combination, fail to disclose, teach or suggest every element recited in the presently amended claims as described in more detail below.

While the rejection of claim 69 is not agreed, with, claim 69 has been amended to improve clarity. As amended, claim 69 recites:

69. A method of dispensing game tickets comprising:
reading a ticket radio frequency identifier (RFID) from a game ticket;
activating the game ticket based on the ticket RFID;
as part of activating the game ticket, writing information to a programmable memory of the game ticket RFID; and
responsive to the activation of the game ticket and an inventory level for tickets of the type of the activated game ticket falling below a predetermined threshold, automatically generating a ticket order for additional tickets.

Amended claim 69 recites “**as part of activating the game ticket, writing information to a programmable memory of the game ticket RFID . . .**” Applicant respectfully submits that Behm, Paulsen, nor Rock, Jr., teach, disclose, or suggest such a feature either implicitly or explicitly. Therefore, Applicant respectfully submits that there exist non-obvious patentable differences between Claim 69 and the cited combination of references and respectfully request withdrawal of the obviousness rejection with respect

thereto. In addition, applicants respectfully request a clearly articulated reason as to why the differences between Claim 69 and the cited references would have been obvious to one of ordinary skill in the art. Applicants respectfully submit that any conclusion of obviousness proffered by the Examiner in this context must be supported with some articulated reasoning with some rational underpinning; mere conclusory statements are not sufficient.

With respect to independent claim 81, while the rejection of claim 81 is not agreed with, claim 81 has been amended to improve clarity. As amended, independent claim 81 recites:

81. A method of tracking game ticket consumables comprising:

responsive to dispensing a game ticket consumable, reading a consumable radio frequency identifier (RFID) from a game ticket consumable, the game ticket consumable being at least one of an item used to create a game ticket in response to a customer request or a non-game ticket item dispensed to game ticket customers;

responsive to the reading and an inventory level for the game ticket consumable falling below a predetermined threshold, automatically generating a consumable order for additional consumables.

None of the cited references teach or suggest the tracking of game ticket consumables where the game ticket consumables are either items used to create game tickets or non-game ticket items dispensed to game ticket customers, such as the ticket stock or marketing materials recited in the dependent claims. To the extent Rock is put forward by the Office Action as allegedly teaching consumable tracking, neither Rock nor the other references teach tracking coded consumables that are used to create game tickets or the materials the other non-game ticket items that are dispensed to game ticket customers. Paulsen's "ticket voucher" is also not used to create game tickets or dispensed to game ticket customers. Accordingly, the cited references, either alone nor in combination, do not teach or suggest all of the features of amended claim

To the extent that a game ticket consumable is comparable to "ticket voucher" of Paulsen, which Applicant does not concede, Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness. As discussed above, Applicants respectfully request a clearly articulated reason as to why the differences between Claim 81 and the cited references would have been obvious to one of ordinary skill in the art.

For at least these reasons, independent claims 69 and 81 are not anticipated by the combination of Behm, Paulsen, and Rock, Jr. By virtue of their dependence on claims 69 and 81, and on their own merits, the combination of Behm, Paulsen, and Rock, Jr. does not anticipate dependent claims 40-49, 70-71, 78-80, and 82-90. Applicant does not otherwise concede the correctness of the Office Action's rejection with respect to any of the dependent claims. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to distinguish further the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

Separately and independently, with respect to claims 82-86, Applicant respectfully submits that the cited combination of references do not teach the tracking of stocks of game ticket writing implements, game ticket marketing materials, or partially preprinted stock used to create an instant win lottery ticket.

Therefore, Applicant respectfully submits that the rejections should be withdrawn.

CONCLUSION

All issues raised in the Office Action are believed to have been addressed. Consideration and allowance of all pending claims is respectfully requested. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (212) 536-3900.

Respectfully submitted

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